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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION,	Case No.05 CV 01114 JW MDL No. 1665 **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S EVIDENTIARY OBJECTIONS RE: DEFENDANTS' MOTIONS FOR SUMMARY JUDGMENT OF INVALIDITY** DATE: TBD TIME: TBD CTRM: 8, 4th Floor JUDGE: Hon. James Ware

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I. EVIDENTIARY OBJECTIONS

Plaintiff Acacia Media Technologies Corporation ("Plaintiff" or "Acacia") objects to the April 17, 1992 report from the David Sarnoff Research Center ("Sarnoff Report") submitted by Defendants in support of their motions for summary judgment of invalidity as Exhibit A to the Declaration of David S. Benyacar in Support of Round 3 Defendants' Motions for Summary Judgment of Invalidity Under 35 U.S.C. §112 of the '992, '863 and '702 Patents and as Exhibit A to the Declaration of Matthew I. Kreeger in Support of the Satellite Defendants' Motion for Summary Judgment of Invalidity of the '992, '863 and '720 Patents.

II. GROUNDS FOR OBJECTIONS

As set forth below, the Sarnoff Report is (1) legally irrelevant, (2) improper opinion testimony from a non-expert, and (3) hearsay, and therefore is inadmissible as evidence in support of Defendants' motions for summary judgment of invalidity.

1. The Sarnoff Report is legally irrelevant under Rule 402 of the Federal Rules of Evidence. Defendants rely on the Sarnoff Report as evidence that the Yurt patents are invalid for failing to meet the written description and enablement requirements of 35 U.S.C. §112. But the first paragraph of the Sarnoff Report explicitly states that the Sarnoff Report "is not intended as an expert evaluation of patentability." (Sarnoff Report, at 2). That statement within the Sarnoff Report affirmatively establishes its lack of relevance. Reinforcing the fact that the Sarnoff Report lacks any probative value in connection with patentability issues such as enablement or written description, nowhere in the Sarnoff Report does the author mention or even express knowledge concerning the applicable legal standard for written description or enablement, and nowhere does the Sarnoff Report state that those applicable legal standards are being applied. As such, the Sarnoff Report has no relevance to the issues of invalidity under section 112 raised by Defendants' motions.

2. Additionally, if offered as opinion evidence of invalidity of the Yurt patents, the Sarnoff Report is inadmissible opinion testimony from a non-expert under Rules 701 – 703 of the Federal Rules of Evidence. Although Defendants refer to the Sarnoff's employees as "experts" (Satellite Defendants' Motion, p. 1), there is no evidentiary foundation to qualify the author of the Report as an expert. Further, the Sarnoff Report does not describe the facts, data or methodology

used by the author to reach any of the opinions relied on by Defendants. Therefore, it is impossible to determine whether any opinion expressed in the Sarnoff Report offered by Defendants is the product of reliable principles and methods. Fed.R.Evid. 702. Moreover, the Sarnoff Report is circumstantially unreliable. It was in the Sarnoff Institute's pecuniary interest to persuade the Yurt patent owners to hire the Sarnoff Institute to further research and develop the disclosed inventions, so of course they would point out how they could be helpful. The Sarnoff Report is therefore inadmissible.

3. The Sarnoff Report is also inadmissible hearsay and should be excluded under Rule 802 of the Federal Rules of Evidence. Defendants are offering the Sarnoff Report, which is an out of Court statement, to prove the truth of the matter asserted therein. F.R.E. 801(c). On page 1 of the Satellite Defendants' Motion, Defendants introduce the Sarnoff Report as follows: "Even the experts at the David Sarnoff Research Center…concluded in 1992 that the patentees had done nothing more than provide a 'starting point for further development' for future video-on-demand systems." Similarly, page 2 of the Round 3 Defendants' Motion quotes the Sarnoff Report: "'The general principles of the system outlined in the patent document appear to be technically correct, though lacking in specific detail…While the document may be serve as a useful starting point for further development, significant additional design/simulation/prototyping work will be required for a meaningful 'proof-of-concept.'" Thus, Defendants are clearly attempting to introduce statements from the Sarnoff Report as proof that the Yurt patent specification is deficient.

Further, none of the exceptions to the hearsay rule are applicable to the Sarnoff Report. Indeed, the Sarnoff Report falls squarely within the policy considerations behind the hearsay rule – the statements in the Sarnoff Report were not made under oath, the author of the Report has not been deposed or called to testify, and there is no opportunity to cross-examine the author. 5-802 Weinstein's Federal Evidence § 802.02. Therefore, the Sarnoff Report is inadmissible as hearsay.

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DATED: December 15, 2008

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